

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Michael Kaplan et al. Art Unit : 2177
Patent No. : 8,166,384 Examiner : Quoc A. Tran
Issue Date : April 24, 2012 Conf. No. : 7627
Serial No. : 09/594,054
Filed : June 14, 2000
Title : ENVIRONMENT-BASED BOOKMARK MEDIA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to adjust total PTA from 2,957 days to 3,875 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. “C Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(C).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before August 14, 2001 (the date that is fourteen months after June 14, 2000, the date on which the application was filed). The PTO mailed the first non-final Office Action on December 8, 2003, thereby according a PTO Delay of 846 days. Patentees do not dispute the PTO’s calculation for this “A Delay” from August 15, 2001 (the day

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June 25, 2012

Date of Deposit or Transmission

Apply S signature /Susan C. Johnson/

Signature

Susan C. Johnson

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after the date that is fourteen months after the date on which the application was filed), to December 8, 2003. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before June 22, 2006 (the date that is four months after February 22, 2006, the date on which an Appeal Brief was filed). The PTO mailed an Examiner's Answer on May 18, 2009, thereby according a PTO Delay of 1,061 days. Patentees do not dispute the PTO's calculation for this "A Delay" from June 23, 2006 (the day after the date that is four months after the date on which an Appeal Brief was filed), to May 18, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 1,907 days (i.e., the sum of 846 days and 1,061 days).

"B Delay"

The period beginning on June 15, 2003 (the day after the date that is three years after June 14, 2000, the date on which the application was filed), and ending April 24, 2012 (the date the patent was issued), is 3,237 days in length.

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to "B Delay" to compensate for that Office delay. The only issue in contention is the correct length of the "B Delay" period. The "PTA 36 Months" entry in the PAIR/PALM system indicates that a total of 0 days were awarded for "B Delay" for this patent. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect.

When Does "B Delay" Occur?

As outlined in Wyeth v. Kappos, 93 U.S.P.Q. 2d 1257 (Fed. Cir. Jan. 7, 2010, affirming Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008)), the period of "B delay" begins on the day after the date that is three years from the filing of the application and concludes upon the issuance of the patent:

Correspondingly, a violation of the B guarantee—the one at the heart of the issue in this case—begins when the PTO fails "to issue a patent within 3 years after the actual filing date of the application in the United States" Id. § 154(b)(1)(B). It ends when "the

patent is issued.” Id. The “period of delay” under the express language of the B clause therefore runs from the three-year mark after filing until the application issues.

Id.

“B Delay” may not include the number of days in the period during which the application is under continued examination. In the present matter, there was no period during which the application is under continued examination. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

Also excluded from the “B Delay” calculation by 35 U.S.C. § 154(b)(1)(B) is “time consumed by appellate review by the Board of Patent Appeals and Interferences.” Id. In the present matter, the Board of Patent Appeals and Interferences (“the Board”) reviewed an appeal proffered by Patentees.

In the instant case, the entire period beginning on June 15, 2003 (the day after the date that is three years after the date on which the application was filed), and ending April 24, 2012 (the date the patent was issued) - a period of 3,237 days - should thus be considered in the calculation of “B Delay.”

How Does Filing a Notice of Appeal Affect “B Delay?”

Properly excluded from a calculation of “B Delay” is “time consumed by appellate review by the Board of Patent Appeals and Interferences.” See 35 U.S.C. § 154(b)(1)(B). As applied by the Office in the calculation of PTA for the instant patent, 37 C.F.R. § 1.703(b)(4) appears to exclude from “B Delay” time periods *not* encompassed by actual appellate review and is therefore inconsistent with the controlling statute. In particular, the Office’s regulation excludes from “B Delay” time starting from when a Notice of Appeal is filed. This reduction of “B Delay” is a clear deviation from the requirements of 35 U.S.C. § 154(b)(1)(B), as it begins an exclusion before any potential appellate review ever takes place. “Appellate review,” if it ever occurs at all after a Notice of Appeal is filed, cannot occur until jurisdiction passes to the Board of Patent Appeals and Interferences.

By its unambiguous meaning, “appellate review by the Board of Patent Appeals and Interferences” can only occur when the Board reviews an appeal. In this case, Notices of Appeal were filed on July 7, 2004, and December 22, 2005. In the first Notice of Appeal case, an

Appeal Brief was filed on November 5, 2004, and the next substantive action issued by the Office was a non-Final Office Action on March 1, 2005. In the second Notice of Appeal case, the BPAI mailed a Board of Patent Appeals and Interferences Decision reversing the Examiner on November 2, 2011.

In the first Notice of Appeal period, the Examiner withdrew the finality of the rejection without filing an Examiner's answer. The case never proceeded to the jurisdiction of the Board, the Board never reviewed the case (nor could it before an Examiner's answer), and no decision was ever issued by the Board – either in favor of the Applicant or in favor of the Office. Clearly, no appellate review by the Board of Patent Appeals and Interferences occurred after the filing of the Notice of Appeal. As such, no reduction of “B Delay” is provided for by 35 U.S.C. § 154(b)(1)(B) in this instance.

How Is “B Delay” Calculated in the Instant Patent?

The “PTA 36 Months” entry in the PAIR/PALM system indicates that the Office awarded 0 days for application pendency of more than three years (i.e., “B Delay”).

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the period between the filing of a Notice of Appeal and the mailing of a non-Final Office Action or Notice of Allowance must be excluded from the “B Delay” calculation. Yet, in the instant patent, time not “consumed by appellate review by the Board of Patent Appeals and Interferences” as provided for in 35 U.S.C. § 154(b)(1)(B) was excluded from the “B Delay” calculation.

In view of the foregoing remarks, Patentees respectfully request that the period of time erroneously deducted from the period of “B Delay” be restored in its entirety to the period of “B Delay.” “B Delay” for this patent is therefore calculated as 3,237 days. The Office calculated only 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the Office's calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 3,237 days. In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 3,237 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

PTO "C Delay"

Patentees filed a Notice of Appeal on December 22, 2005, and the PTO mailed a Board of Patent Appeals and Interferences decision reversing the Examiner on November 2, 2011, thereby according a PTO Delay of 2,142 days. Patentees do not dispute the PTO's calculation for this PTO Delay from December 22, 2005 (the day the Notice of Appeal was filed), to November 2, 2011. See 37 C.F.R. §1.702(2).

In view of the period of "C Delay" detailed above, the total "C Delay" for this patent should be calculated as 2,142 days.

Overlap of PTO "A Delay," "B Delay," and "C Delay"

As detailed above, 1,907 days of "A Delay" accumulated during the following periods:

August 15, 2001, to November 8, 2003; and

June 23, 2006, to May 18, 2009.

As detailed above, 3,237 days of "B Delay" accumulated during the following period:

June 15, 2003, to April 24, 2012.

As detailed above, 2,142 days of "C Delay" accumulated during the following period:

December 22, 2005, to November 2, 2011.

As such, the periods of "A Delay," "B Delay," and "C Delay" overlap (i.e., occur on the same calendar day) for a total of 3,380 days, from June 15, 2003, to November 8, 2003, June 23, 2006, to May 18, 2009, and December 22, 2005, to November 2, 2011.

Applicant Delay

A reply to an Office Action was due on or before March 8, 2004 (the date that is three months after December 8, 2003, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on March 10, 2004, thereby according an Applicant Delay of 2 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from March 9, 2004 (the day after the date that is three months after the date on which the Office Action was mailed), to March 10, 2004. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 23, 2005 (the date that is three months after August 23, 2005, the date on which the Office Action was mailed). Patentees

filed a response to the Office Action on December 22, 2005, thereby according an Applicant Delay of 29 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from November 24, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to December 22, 2005. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 31 days (i.e., the sum of 2 days and 29 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 2,957 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 3,906 days (i.e., the sum of 1,907 days of "A Delay," 3,237 days of "B Delay," and 2,142 days of "C Delay" minus 3,380 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 31 days; and
- 3) Total PTA should be calculated as 3,875 days.

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The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 07844-0427001.

Respectfully submitted,

Date: June 25, 2012

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